

**REMARKS**

Claims 1-56 are pending. No claims are amended or canceled herein.

In the Final Office Action, claims 1, 4-6, 10, 13, 14, 17, 18, 22, 23, 26, 27, 31, 36, and 48 were rejected under 35 USC § 103(a) as allegedly unpatentable over United States Patent No. 7,110,993 (“Soulanille”) in view of United States Patent No. 6,801,906 (“Bates”). Claims 2 and 3 were rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of an article by Weidlich entitled “Search Engine Marketing Revving Up.” Claims 7-9, 11, 12, 15, 19, and 37 were rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2003/0177076 (“Might”). Claims 16 and 24 were rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2004/0167845 (“Corn”). Claims 20 and 21 were rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent No. 6,564,208 (“Littlefield”). Claim 25 was rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2006/0190328 (“Singh”). Claims 28 and 29 were rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of Official Notice. Claim 30 was rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2001/0003177 (“Schena”). Claim 32 was rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2004/0186769 (“Mangold”). Claim 33 was rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of Mangold and further in view of an article by Mahanta et. al entitled “BT dotcom.” Claims 34 and 35 were rejected under Section 103 as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2002/0010015 (“Acres”). Claims 38-42 and 44-46 were rejected under Section 103 as allegedly unpatentable over Soulanille

and the anonymous article “Google Comes Out Ahead,” and further in view of Bates. Claim 43 was rejected under Section 103 as allegedly unpatentable over Soulanille and the anonymous article “Google Comes Out Ahead,” further in view of Bates, and further in view of Might. Claim 47 was rejected under Section 103 as allegedly unpatentable over Soulanille and the anonymous article “Google Comes Out Ahead,” further in view of Bates, and further in view of Littlefield. Claims 49 and 52-56 were rejected under Section 103 as allegedly unpatentable over Soulanille in view of United States Patent Application Publication No. 2003/0093482 (“Watanabe”) and Bates. Claim 50 was rejected under Section 103 as allegedly unpatentable over Soulanille, Watanabe, and Bates, and further in view of Official Notice. Claim 50 was rejected under Section 103 as allegedly unpatentable over Soulanille, Watanabe, and Bates, and further in view of Might.

Initially, Applicants would like to thank the Examiner for the courtesy of the personal interview conducted with Applicants’ representative on July 10, 2007. Although agreement was not reached in the interview, at least for the reasons set forth below, Applicants respectfully submit that all pending claims are in condition for allowance over the prior art of record. Further, Applicants reserve the right to set forth further reasons supporting the patentability of their claims, including reasons supporting these separate the patentability of their dependent claims not explicitly addressed herein, in future papers.

#### **I. Claims 1, 38, and 49**

Independent claim 1 recites “a plurality of groups, wherein each said listing inside responses is associated with at least one said group, each said group being determined at least in part according to said request.” Independent claims 38 and 49 include similar recitations, and claim 1 is therefore discussed herein as exemplary. In the Final Office Action (page 3), the Examiner conceded that Soulanille does not disclose the foregoing recitation. However, the Examiner asserted that Bates compensates for the acknowledged deficiencies of Soulanille. In fact, while Bates’ disclosure does mention “dividing [search] results into multiple groups” (Bates, Abstract), Bates does not teach or suggest “each said group being determined at least in part according to said request.”

Bates teaches saving search parameters when a user performs an Internet search. Then, “if a subsequent related search is made, the search parameters are transferred to the internet search engine and [are] used to reorder or otherwise modify the search results.” (Id.) Before search results are provided to a user,

the search engine re-orders search results by dividing the results into multiple groups, including (in order of priority:[])  
(a) those URLs which are new since the last search; (b) those URLs which have been previously visited [but] have changed . . . ; (c) those URLs which existed before the previous search, but have not been visited by the user; and (d) those URL’s [sic] which the user has previously visited and have not changed.

(Id.) In other words, Bates provides a pre-defined, static set of groups. The presence of a group in Bates’ search results is not in any way dependent on a user’s search request, or on the particular search results returned. Rather, Bates teaches obtaining a set of search results and then putting each result into one of the pre-defined groups.

Bates accordingly does not teach or suggest “each said group being determined at least in part according to said request.” As noted above, Bates’ groups are pre-determined and do not change regardless of the user’s search request. Moreover, because Bates’ groups are pre-determined, one of ordinary skill would have thought it wholly unnecessary to have groups “determined at least in part according to said request.” Therefore, Bates not only fails to teach or suggest “each said group being determined at least in part according to said request,” but Bates actually teaches against this recitation of claim 1. For at least this reason, the present rejection of claim 1 should be withdrawn.

Furthermore, one of ordinary skill in the art would not have thought it possible to combine Soulanille with Bates, as Soulanille is alleged by the Examiner to operate. The Examiner asserted that Soulanille teaches that “said listings within said tier are ordered in accordance with at least one of” the heuristics recited in claim 1. (Final Office Action, page 3.) However, Bates teaches that its URLs and groups are sorted in order of priority. (Bates, column 11, lines 49-54.) The Examiner gave no explanation as to how listings could be ordered within tiers according to the heuristics recited in claim 1 and also according to groups. In fact, Applicants respectfully submit that ordering listings according to the

heuristics recited in claim 1 would preclude ordering the listings according to the prioritized groups taught by Bates. Therefore, for the further reason that Soulanille and Bates could not have been combined, the present rejection of claim 1 should be withdrawn.

Claim 1 is in condition for allowance at least the foregoing reasons, as are claims 2-36 depending therefrom. Moreover, independent claims 38 and 49, and claims 39-48 and 50-56 depending respectively therefrom, are also in condition for allowance for at least the foregoing reasons.

## **II. Claim 10**

Claim 10 recites that “said listings belonging to said tier belong to the same said group.” In rejecting claim 10, the Examiner stated that “the listings belonging to the same tier could easily belong to the same group, if, for example, the highest priority group in Bates filled the tier, or the higher priority groups in Bates produced no results, leaving the tier to be filled by the lowest priority group.” (Final Office Action, page 4.) Thus, the Examiner has plainly conceded that, assuming Soulanille and Bates could be combined, at a minimum many instances of search results returned by such combination would not include “said listings belonging to said tier belong to the same said group.” Further, the Examiner has given no reason why one of ordinary skill would have modified the proposed combination of Soulanille and Bates to ensure that “said listings belonging to said tier belong to the same said group.” At best, the Examiner has contended that the proposed combination of references is potentially compatible with the claimed structure. Applicants respectfully submit that such contention is insufficient to maintain the present rejection of claim 10.

For at least the foregoing reasons, claim 10 is separately patentable, and the rejection of claim 10 should be withdrawn.

## **III. Claim 17**

Claim 17 recites “a plurality of responses, said plurality of responses including a first response and a second response, wherein said first response includes said tier and wherein said second response does not include said tier.” The Examiner conceded that “Soulanille

does not disclose a second response not including a tier of paid listings.” (Final Office Action, page 4.) The Examiner did not cite any reference teaching or suggesting that “said second response does not include said tier.” Rather, the Examiner speculated that “in the case of someone requesting results on a search term for which no advertiser had bid, such a tier would be absent, and presumably only unpaid listings . . . would be displayed.” (*Id.*, pages 4-5.) Applicants respectfully submit that the Examiner’s speculation is an insufficient basis on which to maintain the rejection of claim 17. For at least this reason, the rejection of claim 17 should be withdrawn.

#### **IV. Claim 28**

Claim 28 recites “a plurality of tiers, a plurality of responses, a plurality of requests, and a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests.” Soulanille does not teach or suggest this recitation. In fact, the Examiner acknowledged that “Soulanille does not expressly disclosed that the tier processing rules differ for different search requests.” (Final Office Action, page 13.) However, the Examiner took Official Notice “that it is well known to apply a different and known variations of a technique in different cases.” (*Id.*) From this Official Notice, the Examiner concluded that the foregoing claim recitation would have been obvious “for such obvious advantages as testing to determine which rules worked best, or applying a set of rules either specifically requested in a particular case, or believed to be most suitable to the circumstances.” (*Id.*)

Without either agreeing or disagreeing with the Examiner’s Official Notice, Applicants respectfully submit that the purported prior art of applying “different and known variations of a technique in different cases” does not in any way teach or suggest “a number of said tiers and said tier processing rules differ[ing] for different said requests.” That is, the Examiner’s Official Notice says no more than that it is known to conduct experimentation. However, the mere knowledge of experimentation by one of ordinary skill would not have suggested that “said tier processing rules differ for different said requests.” Applicants’ claim does not recite experimentation, but rather recites “a plurality of tier processing rules,

wherein a number of said tiers and said tier processing rules differ for different said requests.” There is no reason why knowledge of experimentation would have in any way suggested an implemented system requiring that “said tier processing rules differ for different said requests.”

For at least the foregoing reasons, claim 28 is separately patentable. Further, claim 29 is patentable at least by reason of its dependence from claim 28. The rejection of claims 28 and 29 should be withdrawn.

**V. Claim 33**

Claim 33 depends from claim 32 and further recites “a number of hits and a period of time in which to measure said number of hits, wherein said number of hits in said period of time influence said variable per-hit fee.” The Examiner conceded that none of the references applied to claim 32 (Soulanille, Bates, and Acres) “disclosed that the number of hits in time in which to measure said number of hits influence a variable per-hit fee.” (Final Office Action, page 16.) However, the Examiner contended that Mahanta compensates for the knowledge to deficiencies of the other cited prior art by allegedly disclosing “assuring the usefulness of a site by requiring a minimum number of impressions or click-through.” (*Id.*, page 17.) In fact, neither Mahanta nor any of the other cited references disclosed that “said number of hits in said period of time influence said at variable per-hit fee.”

The portion of Mahanta cited by the Examiner merely discusses the right of an e-tailer in India to recognize revenues for click-throughs of banner advertisements. (“In the case of revenue from banners and other paid ads where the fee is contingent on a minimum number of impressions or click-throughs, the revenue should not be recognized until of that promised level has been reached.”) This disclosure by Mahanta in no way teaches or suggests that “said number of hits in said period off time influence said a variable per-hit fee.” In fact, Mahanta does not include teachings or suggestions that have anything to do with variable per-hit fees at all.

Further, the Examiner’s speculation that “it would have been obvious . . . for the number of hits or period of time to influence the variable per-hit fee, for such obvious

advantages as charging more during times of the year when advertising is more in demand” is wholly unsupported by the prior art of record. To the extent the Examiner is taking Official Notice, the Examiner is respectfully requested to provide support for such official notice in response to this paper. At present, the Examiner has stated insufficient basis for rejecting claim 33, and that rejection should be withdrawn.

### **CONCLUSION**

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 66703-0014. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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Respectfully submitted,

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